

Martin Brady  
Serial No. 09/228,109

Reconsideration of this application is respectfully requested.

Claims 3 through 5, and 7 through 15 are pending in this application. Claims 3 through 5 and 7 through 9 are allowed, claims 10 through 13 rejected, and claims 14 and 15 added above. New claims 14 and 15 are dependent upon allowed claim 8 and presumably will be allowable therewith. They are supported by the specification in the paragraph beginning at page 5, line 14, and the elements of the drawings referred to therein.

It is noted that the Office Action of September 27, 2002, omits reference to previously allowed and still pending claims 3 through 5 and 7 through 9. Counsel assumes the omission was inadvertent and will be corrected in any subsequent Office Action.

Claims 10 through 13, which had been allowed by the Board of Patent Appeals and Interferences, are kept in the same form allowed by the Board.

Reconsideration is requested of the rejection of claims 10 through 13 under 35 U.S.C. 103(a). The primary reference relied upon for rejecting claims 10 through 13 is the previously-cited Presto manual, which shows an electric can opener for domestic use having a jar opener. The secondary references are two newly-

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cited patents, Davies (4,152,831) and Nielsen et al. (5,791,608).

With regard to claim 10, the issue is whether or not the examiner's proposed combination of references renders obvious a "household opening appliance comprising an electric can opener having a housing," such as shown by Presto, "and a scissors holder on said housing capable of releasably retaining a scissors on said housing." Claim 11 depends on claim 10, and therefore involves the same issue, and additionally recites "a sheath for a scissors on said housing."

The Board of Patent Appeals and Interferences was faced with the same issues, but with a different set of secondary references, and concluded, in its decision dated May 20, 2002, that it shared "the examiner's view that the sheath taught by Hoover could be attached to any suitable support, but we fail to perceive any teaching, suggestion or incentive in the applied references which would have motivated an artisan to attach either the shear/bottle opener utensil of Rauh or the sheath taught by Hoover to the housing of an electric can opener, such as that of Presto." The Board further reasoned: "Even assuming the examiner is correct that the combination of the Rauh utensil with the Presto can opener would yield a more versatile device, the applied references are devoid of any recognition of such a

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versatility advantage from the proposed combination."

(Quotations are from pages 5 and 6 of the Board's decision.)

(Emphasis in original.) In this connection, in Footnote 3 on Page 6 of the Board's opinion, the Board stated: "The Presto can opener, with its can, bottle, bag and jar opening equipment is already quite versatile..." The Board further suggested that the rejection of claims 10 through 13 was based on an improper use of hindsight.

Counsel believes the Board's reasoning applies also to the new rejection of claims 10 through 13, and impermissible hindsight is the real basis for the new rejection.

The newly cited Davies patent shows tool holders that rely upon a bias produced by springs that force the jaws of the tool open to releasably retain the tool in the tool holder, and is not designed to be used for holding scissors. Davies is apparently used in the rejection of the claims because it discusses various possible orientations and mounting arrangements (at col. 2, lines 15-21) and, at column 3, lines 30-33 proclaims that "The holder can be positioned exactly where it is most convenient." And is effective "whatever its orientation." As noted above, on page 5 of its opinion, the Board noted that the "sheath taught by Hoover could be attached to any suitable support." In this respect,

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Davies is no more pertinent than Hoover; there is no provision in the art applied by the examiner of a teaching, suggestion or incentive to cause an artisan to attach a Davies tool holder to the Presto can opener.

The Nielsen et al. patent discloses and claims a paint brush holder made of a flexible sheet material, such as canvas or fabric, which may have a magnet for attracting a metal part on a paint brush. At col. 2, lines 19 through 35, Nielsen et al. suggest numerous other uses for their holder. Thus, Nielsen et al. suggest using their holders to hold large and small parts to the side of solvent tubs while cleaning, to hold hand tools attached to a vehicle's motor compartment, fender or undercarriage, to hold loose items such as nuts and bolts, or to keep "scissors, instruments, bobbins, gauges and other hand tools within reach" while keeping the operator's work space clear by attaching a holder to the front or side of a metal machine (such as a sewing machine). Beginning at col. 2, line 30, Nielsen et al. assert that the "device allows mobile repair services to store their most used tools and parts on accessible surfaces, such as pick-up side walls, van side walls and ceilings, metal tool box lids and sides, refrigerators, and washer and dryers without scratching or marring surfaces."

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Thus, as with the Hoover reference considered and dismissed by the Board and as with Davies, counsel would readily agree that the Nielsen et al. holder can be mounted on many objects and surfaces. There remains no teaching, incentive or suggestion in the prior art for mounting a scissors holder on the Presto can opener.

Claims 12 and 13 are deemed allowable along with claims 10 and 11.

The several other references newly cited in the Office Action of September 27, 2002, have been considered. These do not appear to add anything of substance to suggest the claimed invention which is not already included in the Presto, Davies and Nielsen et al. disclosures.

For the foregoing reasons, each of claims 3 through 5 and 7 through 15 deemed allowable. Favorable action is requested.

Respectfully submitted,

  
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